

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Dacosta) Art Unit: 2445
)
Serial No.: 10/782,345) Examiner: Hossain
)
Filed: February 19, 2004) 50T5722.02
)
For: SYSTEM AND METHOD FOR) September 2, 2009
AUTHENTICATING COMPONENTS IN) 750 B STREET, Suite 3120
WIRELESS HOME ENTERTAINMENT) San Diego, CA 92101
SYSTEM)

APPEAL BRIEF

Commissioner of Patents and Trademarks

Dear Sir:

This brief is submitted under 35 U.S.C. §134 and is in accordance with 37 C.F.R. Parts 1, 5, 10, 11, and 41, effective September 13, 2004 and published at 69 Fed. Reg. 155 (August 2004). This brief is further to Appellant's Notice of Appeal filed July 9, 2009.

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(1) Real Party in Interest

The real parties in interest are Sony Corp. and Sony Electronics, Inc.

(2) Related Appeals/Interferences

No other appeals or interferences exist which relate to the present application or appeal.

(3) Status of Claims

Claims 10-13 and 30 are pending and rejected, which rejections and claims are appealed, and Claims 1-9 and 14-29 have been canceled.

(4) Status of Amendments

An amendment canceling claims has been submitted and presumably will be entered for appeal.

(5) Summary of Claimed Subject Matter

As an initial matter, it is noted that according to the Patent Office, the concise explanations under this section are for Board convenience, and do not supersede what the claims actually state, 69 Fed. Reg. 155 (August 2004), see page 49976. Accordingly, nothing in this Section should be construed as an estoppel that limits the actual claim language.

Claim 10 sets forth a home entertainment system that includes a wireless system server (12, figure 1; page 5, line 3) having a primary communication system (16, figure 1; page 6, line 8) and a wireless component (24, figure 1, page 7, line 10) having a primary communication system (26, figure 1; page 7, line 12) configured for communicating with the primary communication system of the server. The component sends configuration information to the server using a secondary communication system

(28, figure 1; page 7, line 19) that is out-of-band with the primary systems. The configuration information is exchanged between the server and component only when the distance between them is within a communication distance and a user manipulates a button (23, figure 1; page 7, line 8) on the server and/or (34, figure 1; page 8, line 3) on the component (page 9, line 5 - page 10, line 5).

(6) Grounds of Rejection to be Reviewed on Appeal

All pending claims (10-13 and 30) have been rejected under 35 U.S.C. §103 as being unpatentable over Sayers, USPP 2005/0083882 in view of Official Notice.

(7) Argument

As an initial matter, it is noted that according to the Patent Office, a new ground of rejection in an examiner's answer should be "rare", and should be levied only in response to such things as newly presented arguments by Applicant or to address a claim that the examiner previously failed to address, 69 Fed. Reg. 155 (August 2004), see, e.g., pages 49963 and 49980. Furthermore, a new ground of rejection must be approved by the Technology Center Director or designee and in any case must come accompanied with the initials of the conferees of the appeal conference, *id.*, page 49979.

The error in the rejection of Claim 10 stems from the examiner's reliance on the button-pushing discussion in paragraphs 39 and 40 of Sayers. This discussion relates to a button on the IR configuration device 510 - the element in Sayers formerly relied on by the examiner for the remote control relay of now-cancelled Claim 1. But Claim 10 requires *not the remote control* to have a button for instigating configuration information exchange but rather the server or the wireless component communicating with each other over two paths, primary and secondary, to have the button. The device 510 of Sayers does not communicate with anything over more than one path so it cannot be used as either the claimed wireless

component or server, and nothing in Sayers suggests that the button-pushing discussion of paragraphs 39 and 40 is intended to be anything other than unique to the remote control (IR configuration device 510) embodiment. Accordingly, the rejection of Claim 10 is clear error.

Furthermore, as KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727 (2007) makes clear, "rejections based on obviousness grounds cannot be based on mere conclusory statements", id. at 1741; "KSR provided convincing *evidence*" of obviousness, id. at 1731 (emphasis mine). This is of relevance to Claim 10 because of the allegation in the Office Action that paragraphs 39 and 40 teach "within a predetermined distance". They do not. In Sayers what is of interest is line-of-sight, i.e., the user points an IR transmitter at an IR receiver. But line of sight is not the same thing as being within a communication distance as claimed, since the line of sight distance between two objects can range from inches to infinity. Conversely, in Sayers the two components can be within inches of each other but if a third object intervenes, the receiver will not detect the transmitted IR. Accordingly, having failed to explain or demonstrate by evidence that the skilled artisan regards a potentially infinite "line of sight" (an apple) to be the same thing as "within a communication distance" (an orange), the rejections are clearly erroneous.

In addition to the above errors, the rejections are further reversible for the improper taking of official notice in changing the environment of Sayers to fit Claim 10. Under the law, the taking of official notice can be taken only of facts that "are capable of instant and unquestionable demonstration as to defy dispute", giving, as examples, adjusting flame intensity as needed for heat and tape recorders automatically erasing old data when new data is recorded onto them, *In re Ahlert*, 424 F.2d 1088, 1091, (CCPA 1970). Official notice of dependent claim limitations "might be appropriate" but only if the facts so noticed "are of notorious character". This can hardly be said of the currently noticed-away claim

element of employing a specific method for exchanging configuration information in a home entertainment system.

Accordingly, official notice "is permissible only in some circumstances", and should be "rare" in final rejections. In any case, according to the MPEP (§2144.03) official notice is most inappropriate of technical facts in areas of esoteric technology or of specific knowledge of the prior art. Still further, "ordinarily there must be some form of evidence in the record to support an assertion of common knowledge", and "general conclusions concerning what is basic knowledge without specific factual findings will not support an obviousness rejection."

Respectfully submitted,



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APPENDIX A - APPEALED CLAIMS

10. A home entertainment system, comprising:

at least one wireless system server having at least a primary communication system; and

at least one wireless component having at least a primary communication system configured for communicating with the primary communication system of the server, wherein the component sends configuration information to the server using a secondary communication system that is out-of-band with the primary systems, wherein the configuration information is exchanged between the server and component only when the distance between them is within a communication distance and a user manipulates at least one button on at least one of the server, and the component.
11. The system of Claim 10, wherein the secondary communication systems are personal area networks (PAN).
12. The system of Claim 10 wherein the primary communication system is an 802.11 system.
13. The system of Claim 12, wherein the server is established by a set-top box receiver.
30. The system of Claim 10, wherein the configuration information includes an encryption key, a media access address, and a network name.

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APPENDIX B - EVIDENCE

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

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APPENDIX C - RELATED PROCEEDINGS

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)